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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,484	08/29/2001	Kevin McCarthy	367.40541X00	4845
20457	7590	10/04/2005		
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMNER PESIN, BORIS M	
			ART UNIT 2174	PAPER NUMBER

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,484

Applicant(s)

MCCARTHY, KEVIN

Examiner

Boris Pesin

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This communication is responsive to the amendment filed 07/14/2005.

Claims 16-29 are pending in this application. Claims 16 and 18 are independent claims. In the amendment filed 07/14/2005, Claims 1-15 were canceled and claims 16-29 were added as new. This action is made Non-Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant cites pages 9, lines 17-33 and page 10 lines 1-4 of the specification for support of the "transmitting a reminder to a remote second communication terminal via a wireless communication network based on the alerting" limitations. However the Examiner believes that there is no support for that limitation in the cited passage. The cited passage refers to sending a reminder with the time and

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the text, however this is not based on the alerting. Sending a reminder at a specific time and sending a reminder *with* a specific time of when it should be executed are two different functionalities.

In regards to claims 25-29, the specification does not teach what is a "Smart Messaging Specification". The specification simply alludes to Nokia's Smart Messaging Specification, but gives no description.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nokia 6100 User's Guide, 9351506, Issue 2

("Nokia," http://nds1.nokia.com/phones/files/guides/6110_usersguide_en.pdf, June 7th, 1998) in view of Alperovich et al. (US 6119014).

In regards to claim 16, Nokia teaches a method of handling reminders in a handportable communication terminal wherein a reminder is an electronic message which includes a reminder time and date and a reminder text which reminds a user of the terminal that an action should be taken as indicated in the text and which causes the terminal to generate an alarm alerting a user of the terminal that the action should be taken when the time and date is reached, comprising:

manually entering characters into a text editor for providing that reminder text (page 53, column 2, lines 16-19);

entering time information into a time entry for setting the reminder time (page 53, column 2, lines 29-35);

providing real time clock information from a clock application (page 43, column 2, lines 1-4);

comparing the time information with the real time clock information (page 54, column 2, lines 1-3);

alerting a user of the terminal with an alarm when the real time clock has reached the reminder time and date (page 54, column 2, lines 1-3).

Nokia does not teach transmitting the reminder to a remote second communication terminal via a wireless communication network based on the alerting with an alarm. Alperovich teaches, "The SMS Service Center 360 can have a SMS-org application 370 located therein, which can receive the SMS messages 320 and

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associated reminder indicators 315 from the originating subscriber 380 and store them in a memory 375 within the SMS Service Center 360 until the time associated with the reminder indicator is reached. Thereafter, the SMS Service Center 360 can send the SMS message 320 to the MS 300 for display on the MS display 304." (Column 4, Line 66). It would have been obvious to one of ordinary skill in the art to modify Nokia with the teachings of Alperovich and include a reminder transmitting mechanism based on an alert with the motivation to provide the user with a convenient method of reminding others of tasks that need to be accomplished.

In regards to claim 17, which is dependent on claim 16, Nokia teaches that the alerting comprises display of the reminder text (page 54, column 2, lines 1-3).

As per independent claim 18, Nokia teaches a handportable communication terminal, including a control unit, a user interface including a display and text input means with said user interface being controlled by the control unit for generating reminders wherein a reminder is an electronic message which includes a reminder time and date and a reminder text which reminds a user of the terminal that an action should be taken as indicated in the text and which causes the terminal to generate an alarm alerting a user of the terminal that the action should be taken when the time and date is reached (page 53, column 2, lines 16-19), text input means, said user interface being controlled by the control unit (page 53, column 1, lines 1-8), a clock application controlled by the control unit and having a clock function and a reminder application which the display can present (page 43, column 2, lines 1-4), the reminder application

including a text editor window in which the user through the user interface enters a reminder text label (page 53, column 2, lines 16-19), and a time entry window in which the user through the user interface enters a date and time for the reminder text is displayed by the display (page 53, column 2, lines 29-35), and an alert unit that generates an alarm which alerts the user when the clock reaches the entered date and time for the reminder (page 54, column 2, lines 1-3). Nokia does not teach that the reminder application allows the user to transmit the reminder to a remote second communication terminal via a wireless communication network based on the alarm (page 53, column 2, lines 1-4). Alperovich teaches, "The SMS Service Center 360 can have a SMS-org application 370 located therein, which can receive the SMS messages 320 and associated reminder indicators 315 from the originating subscriber 380 and store them in a memory 375 within the SMS Service Center 360 until the time associated with the reminder indicator is reached. Thereafter, the SMS Service Center 360 can send the SMS message 320 to the MS 300 for display on the MS display 304." (Column 4, Line 66). It would have been obvious to one of ordinary skill in the art to modify Nokia with the teachings of Alperovich and include a reminder transmitting mechanism based on an alert with the motivation to provide the user with a convenient method of reminding others of tasks that need to be accomplished.

As per claim 19, which is dependent on claim 18, Nokia teaches a clock application providing real time clock information to the reminder application, and said reminder application displays a reminder note when the real time clock has reached the reminder time (page 43, column 2, lines 1-4 and page 54, column 2, lines 1-3).

As per claim 20, which is dependent on claim 18, Nokia teaches that the reminder application provides the user access to add new reminders (page 53, column 2, lines 11-35), view all existing reminders (page 54, column 1, lines 18-23) and erase existing reminders (page 54, column 1, lines 10-18).

As per claim 21, which is dependent on claim 18, Nokia teaches that the reminder application upon receiving instructions to send a reminder requests the user to enter a phone number of the second communication terminal which is to receive the reminder (page 53, column 2, lines 1-4).

As per claim 22, which is dependent on claim 18, Nokia teaches that the reminder application allows the user to search for the phone number of the second communication terminal in an internal phone number database of the transmitting terminal (page 20, column 1, lines 16-24, *user can search a phone number database to find phone numbers*).

As per claim 23, which is dependent on claim 21, Nokia teaches that the reminder application allows the user to inspect a reminder received from a remote second communication terminal via a wireless communication network (page 53, column 2, lines 1-5, *reminders can be sent as messages* and page 32, column 1, lines 6-15, *messages can be received on handportable device*).

As per claim 24, which is dependent on claim 21, Nokia teaches that the reminder application furthermore allows the user to save or discard a reminder received from a remote second communication terminal (page 32, column 2, lines 7-10 and page 32, column 1, lines 15-25).

Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nokia 6100 User's Guide, 9351506, Issue 2 ("Nokia," http://nds1.nokia.com/phones/files/guides/6110_usersguide_en.pdf, June 7th, 1998) in view of Alperovich et al. (US 6119014) in further view of Mercer et al. ("Mercer," US006167429A).

As per claim 25, which is dependent on claim 21, the teachings of Nokia and Alperovich in regards to claim 21 have been discussed above. Nokia and Alperovich do not explicitly disclose that the reminders are transferred via the wireless communication network included in a message according to the Smart Messaging Specification.

Mercer teaches that the reminders are transferred via the wireless communication network included in a message according to the Smart Messaging Specification (column 1, lines 38-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Nokia and Alperovich with a means to send communications according to the Smart Messaging Specification, as taught by Mercer, with the motivation to enable access to a range of text based services from a mobile phone (column 1, lines 41-42).

Claims 26-29 are similar in scope to claim 25, and are therefore rejected under similar rationale.

Response to Arguments

Applicant's arguments with respect to claims 16-29 have been considered but are moot in view of the new ground(s) of rejection.


Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (571) 272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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